

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

In re application of Valerie M. Bennett, et al.

Serial No.: 10/733,625

Filed: December 11, 2003

For: Intelligent Subscription Builder

Art Unit: 2443

Examiner: David E. England

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop Amendment
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby request review of the Non-Final Rejection in the Office Action mailed July 31, 2009 in the above-identified Application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. Review is requested for the reasons stated on the attached sheets.

Respectfully submitted,

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GROUND OF REJECTION PRESENTED FOR REVIEW

The **Ground of Rejection** presented for review is a rejection of Claims 1, 3 - 4, and 13 - 21 under 35 U. S. C. §103(a) as being unpatentable over U. S. Patent Publication 2004/0043758 to Sorvari et al. (hereinafter, “Sorvari”) in view of U. S. Patent 6,731,393 to Currans.

ARGUMENT

Applicants reserve the right to argue additional grounds if this Petition is denied.

Applicants respectfully note that the rejections in the Office Action fail to state what part of a cited text passage or figure is being relied on, or how any part of that text passage or figure is being interpreted by the Examiner, when discussing their claim language. This provides Applicants with no guidance for formulating a response to the rejection. Accordingly, Applicants have been left to guess as to what the Examiner is actually citing, and how that has been interpreted. Any continuing disagreement between Applicants and the Examiner as to whether a claim limitation is taught by the references is therefore a direct result of the lack of specificity in the Office Action.

Furthermore, Applicants respectfully submit that this approach to analyzing their claim language in the Office Action is legally deficient, as it does not meet the requirements laid out in 37 CFR §1.104, “Nature of Examination”, which states in paragraph (c)(2),

In rejecting claims for ... obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained ... (emphasis added)

In addition, Applicants respectfully submit that a *prima facie* case of obviousness under 35 U.S.C. §103 has not been made out because the cited references, whether taken singly or in

combination, do not teach or suggest all of the claim limitations. Section 2143.03 of the MPEP, “All Claim Limitations Must Be Considered” (which is found within MPEP §2143, titled “Examples of Basic Requirements of a *Prima Facie* Case of Obviousness”), quotes *In re Wilson*, 165 USPQ 494, 496 (C.C.P.A. 1970), which held that “*All words* in a claim must be considered in judging the patentability of that claim against the prior art.” (emphasis added). Applicants respectfully submit that all words of their claim language have not been properly considered, in violation of this requirement from MPEP §2143.03, as will now be demonstrated.

Referring first to Applicants’ independent Claim 1, the final element of this claim recites subsequently evaluating the content generated by the content source, using the trigger, to determine whether any of the at least one portion of the content is considered a match to the trigger and automatically sending each matching portion of the content to the user as the subscription and scheduling time on an electronic calendar of the user when any of the at least one portion of the content is considered a match to the trigger (emphasis added)

The Office Action admits that Sorvari “does not specifically teach” this claim language (Office Action, page 3, last 4 lines), and then cites Currans, col. 12, line 58 - col. 13, line 52 and Figs. 6 - 8 (Office Action, page 4, lines 1 - 3). Applicants respectfully note that Currans is directed to “automatically determining media type in a printing device media tray” (see the Title and Abstract). A sensor is positioned so as to locate and identify a code containing the media type. Abstract, lines 4 - 6.

As noted above, the Office Action fails to explain how the cited Figs. 6 - 8 and cited text in col. 12, line 58 - col. 13, line 52 are being interpreted, and Applicants are therefore left to guess as to the purported relevance of the cited figures and text to their claim language. Accordingly, Applicants present herein comments regarding these citations, demonstrating that under no interpretation do the cited figures and text teach, or suggest, the claim language for which they are

cited.

Fig. 6 of Currans illustrates a graphical user interface where a user can “tell us about yourself”. See the title in the figure. In col 3, lines 29 - 30, Currans describes Fig. 6 as “show[ing] how user profile information is acquired from a user ...”. Applicants respectfully submit that this figure appears to be irrelevant to their claim language that pertains to scheduling time on a user’s calendar, as the figure contains no entries pertaining to time or to a calendar. Currans describes his Fig. 7 as “show[ing] a print schedule for the delivery of documents ...”. Col. 3, lines 31 - 32, emphasis added. At col. 10, lines 1 - 3, Currans states “**FIG. 7** shows one example of printing schedule **390**, of the type that might be used in an enhanced version of HP’s Instant Delivery program.”, and col. 12, lines 39 - 41 state “Referring again to print schedule **390** shown in **FIG. 7**, it can be seen that many different types of documents can be required to be printed.”. Applicants respectfully submit that these citations clearly show that Currans’ Fig. 7 is not pertinent to scheduling time on a user’s calendar. Col. 3, lines 33 - 34 describes Fig. 8 as “show[ing] how the print schedule of **FIG. 7** can be modified by the user”. This is also stated at col. 13, lines 26 - 27. Applicants are unable to determine how allowing a user to modify a schedule at which documents are going to be printed is in any way relevant to scheduling time on a user’s calendar.

Referring now to the cited text of Currans, this passage addresses a document **12000** that may be a daily calendar which has been requested by the user to print automatically at a certain time of day. Where does this text supposedly disclose scheduling time on a user’s calendar? Requesting that the calendar is automatically printed at a certain time of day, as discussed at col. 12, lines 61 - 65 and col. 13, lines 19 - 20, in no way teaches scheduling time on the calendar. Where does the cited text disclose comparing anything to a trigger, such that the scheduling of the time on the calendar occurs when content is considered a match to the trigger? Applicants find no

such teaching, or suggestion, in the cited text. Furthermore, note the antecedent for “any of the at least one portion of the content”: this antecedent must be considered when evaluating all of the words of the claim language as required by the above-cited MPEP §2143.03. This antecedent is found on lines 5 - 6 of Claim 1, where it is recited as follows:

the candidate content subscription indicating at least one portion of content generated by a content source

In other words, the time is scheduled on the user’s calendar when some portion of content indicated in a candidate content subscription matches a trigger. Applicants also fail to find any teaching or suggestion of this claim language in the cited portions of Currans.

Applicants also note that the extent of the Office Action explanation of Sorvari’s “use” of a calendar is as follows: “Sorvari teaches the use of calendar information”, citing para. [0308]. Office Action, page 3, last 4 lines. However, what is described in the cited para. [0308] is “... an input ... from a calendar application program indicating that a meeting is starting in 25 minutes time” (lines 1 - 5, emphasis added) or as another example of an input, “... the calendar application program indicates that Lisa is having a birthday tomorrow ...” (lines 5 - 8). Receiving input from a calendar application program, as in these cited portions of para. [0308], indicates that events are already scheduled on the user’s calendar, which in no way teaches or suggests Applicants’ recited “scheduling time on an electronic calendar of the user when any of the at least one portion of the content is considered a match to the trigger”.

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Applicants also respectfully submit that the purported motivation for combining Sorvari and Currans is flawed. See page 4, lines 3 - 8 of the Office Action, where the motivation is presented. Interestingly, this is the exact same motivation that was used in the prior Office Action

for combining Shaffer with Sorvari. (Office Action dated March 6, 2009, para. 26.) The motivation is stated as “... utilizing a user calendar to have information sent to the user enables the user to dictate when they would receive information and not have information sent every time a match is made from the trigger. This would also lessen the amount of network traffic in the system.”. Applicants respectfully note that their claim language does not recite sending information to the user at a scheduled time, or sending information as “dictated” by a user. Rather, the claim language recites “automatically sending each matching portion ... and [also] scheduling time on an electronic calendar ... when ... at least one portion of the content” matches the trigger. In other words, the claim language does not recite that the user “dictates” when the information is sent to the user, and in sharp contrast to the assertion in the Office Action, the claim language recites that the information would be automatically sent to the user when it matches the trigger.

In view of the above, Applicants respectfully submit that the Office Action fails to consider all of the words as recited in Claim 1, and fails to cite references that teach or suggest all of the claim language of Claim 1 when considering all of the words. Accordingly, a *prima facie* case of obviousness has not been made out, and without more, Claim 1 is deemed patentable. Independent Claims 20 and 21 recite claim language analogous to that of Claim 1, and the arguments presented above therefore apply to those claims as well. Accordingly, Claims 20 and 21 are also deemed patentable over the references. Dependent Claims 3 - 4 and 13 - 19 are deemed patentable at least by virtue of the allowability of independent Claim 1 from which they depend.

In summary, Applicants respectfully request that the rejection in the Office Action be reversed by the appeal conference prior to the filing of an Appeal Brief.